



Paper 9

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OFFICE OF PETITIONS

In re Application of
Gers-Barlag, et al. :
Application No. 09/265,779 : **ON PETITION**
Filed: 10 March, 1999 :
Attorney Docket No.: Beiersdorf 416.2-KGB :

This is a decision on the pleadings filed on 21 October, 2002, under 37 C.F.R. §1.137(b)¹ to revive the above-identified application.

For the reasons set forth below, the petition is **GRANTED**.²

BACKGROUND

A review of the record reveals:

- the instant application (Application No. 09/265,779 (the '779 application) was filed on 10 March, 1999, as a divisional application of the parent Application No. 08/788,147 (the '147 application), which then issued as a Patent No. 5,968,483 (the '483 patent) on 19 October, 1999;

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

² Pursuant to Petitioner's authorization, the petition fee (\$1,280.00) is charged and the incorrect fee (\$110.00) previously charged is credited to Deposit Account 14-1263.

- contemporaneously with the '779 application Petitioner filed a preliminary amendment, and on 22 June, 1999, the Examiner issued a non-final Office action rejecting pending claims 7 - 12, and setting out a three- (3-) month shortened statutory period (SSP) for reply;
- Petitioner at first contended that he then-intended to file (via U.S. Postal Service (USPS) Express Mail, Label No. EE559518099US) into the '779 application a continued prosecution application (CPA) with a request and fee for a three- (3-) month extension of time, however:

--even on the second consideration of Petitioner's demand for the withdrawal of the holding of abandonment, Petitioner failed to submit a copy of the date-stamped USPS Express Mail Label No. EE559518099US evidencing receipt thereof by the USPS;

--consecutive multiple searches of the USPS Tracking system and the Office Express Mail database evidence no record of receipt for transmittal by the USPS of a such-numbered item, nor its receipt by the Office;

--while Petitioner contended he intended to file the materials in question into the '779 application, the copies of the papers submitted by Petitioner clearly showed that if they were submitted--a contention certainly in question--he attempted to file the papers not into the '779 application but into the '147 application (then-no-longer pending but having issued as the '483 patent);³

- when no proper and timely response was filed, the instant '779 application went abandoned after midnight 22 September, 1999;
- Notice of Abandonment was mailed on 16 March, 2000;
- while Petitioner contends that:

--he received the Notice of Abandonment on 20 March, 2000, and submitted via FAX on 21 March, 2000, copies of the alleged 22 December, 1999, filing; and

--he then submitted a written 29 August, 2000, Status Inquiry and made telephone inquiries on 24 October, 2000, and 6 February, 2001,

the record clearly demonstrated that notwithstanding Petitioner's contentions, Petitioner's written inquiry was made not into the '779 application but into the already issued '147 application--the '483 patent;

³ Even the "Notice of Change of Firm Name" alleged to have been filed by Petitioner on 22 December, 1999, contained the incorrect '147 application number. However, as demonstrated by the lack of documentary proof of submission, it appears not unlikely that even this erroneous notice never was mailed by Petitioner.

- through his first petition to the Group Director and second petition seeking to overturn the decision of the Group Director, Petitioner contended that the Office failed to follow its procedures as set forth in MPEP §201.06(d);⁴

⁴ The commentary at MPEP §201.06(d) provides in pertinent part:
201.06(d) 37 C.F.R. 1.53(d) Continued Prosecution Application (CPA) Practice

IN GENERAL

In addition to the provisions of 37 C.F.R. 1.53(b), a continuation or divisional (but not a continuation-in-part) application may be filed under 37 C.F.R. 1.53(d) if the prior application is: (A) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by 37 C.F.R. 1.51(b); (B) a design application that is complete as defined by 37 C.F.R. 1.51(b); or © the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371. Applicant may wish to consider filing a request for continued examination (RCE) under 37 C.F.R. 1.114 for utility or plant applications filed on or after May 29, 2000. See MPEP § 706.07(h). A continuation or divisional application filed under 37 C.F.R. 1.53(d) is called a "Continued Prosecution Application" or "CPA." A CPA has a number of advantages compared to a continuation or divisional application filed under 37 C.F.R. 1.53(b).

CONDITIONS FOR FILING A CPA

A continuation or divisional application may be filed under 37 C.F.R. 1.53(d), if the prior nonprovisional application is: (A) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by 37 C.F.R. 1.51(b); (B) a design application that is complete as defined by 37 C.F.R. 1.51(b); or © the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371. The term "prior nonprovisional application" in 37 C.F.R. 1.53(d)(1) means the nonprovisional application immediately prior to the CPA. A complete application as defined by 37 C.F.R. 1.51(b) and a "national stage of an international application in compliance with 35 U.S.C. 371" must each contain, *inter alia*, the appropriate filing fee and a signed oath or declaration under 37 C.F.R. 1.63. In addition, a continuation or divisional application filed under 37 C.F.R. 1.53(d) must be filed before the earliest of: (A) payment of the issue fee on the prior application, unless a petition under 37 C.F.R. 1.313© is granted in the prior application; (B) abandonment of the prior application; or © termination of proceedings on the prior application.

INITIAL PROCESSING

A CPA request will be initially processed by the TC assigned the prior application. The TC will verify that (A) the prior application is a utility or plant application or a national stage of an international application filed before May 29, 2000, or is a design application, (B) the correct application number of the prior nonprovisional application is identified in the request, © the request is properly signed, (D) the prior nonprovisional application was pending on, and that the issue fee has not been paid in the prior non-provisional application on or prior to, the filing date of the CPA request, (E) the prior nonprovisional application was complete under 37 C.F.R. 1.51(b) (e.g., the filing fee has been paid and a signed oath or declaration under 37 C.F.R. 1.63 has been filed in the prior application), and (F) the proper filing fee has been paid in the CPA. If a CPA request of a utility or plant application or a national stage of an international application that was filed on or after May 29, 2000 is filed, the CPA is improper and will automatically be treated as a request for continued examination (RCE) under 37 C.F.R. 1.114, see MPEP § 706.07(h), paragraph IV. If one or more other conditions for filing a CPA have not been satisfied or the proper filing fee has not been paid, the applicant will be so notified and no examination will be made in the CPA until the filing error has been corrected or the proper filing fee submitted. See 37 C.F.R. 1.53(h). If an examiner discovers that an improper or incomplete CPA has been forwarded to the examiner in error, the application should be immediately returned to a supervisory applications examiner (SAE) within the TC. The improper or incomplete CPA is not to be returned to OIPE.

INCORRECT PARENT APPLICATION NUMBER IDENTIFIED

A request for a CPA must identify the prior nonprovisional application (37 C.F.R. 1.53(d)(2)(I)) by application number (series code and serial number) or by serial number and filing date. Where a paper requesting a CPA is filed which does not properly identify the prior nonprovisional application number, the TC should attempt to identify the proper application number by reference to other identifying information provided in the CPA papers, e.g., name of the inventor, filing date, title of the invention, and attorney's docket number of the prior application. If the TC is able to identify the correct application number of the prior application, the correct application number should be entered in red ink on the paper requesting the CPA and the entry should be dated and initialed. If the TC is unable to identify the application number of the prior application and the party submitting the CPA papers is a registered practitioner, the practitioner may be requested by telephone to supply a letter signed by the practitioner providing the correct application number. If all attempts to obtain the correct application number are unsuccessful, the paper requesting the CPA should be returned by the TC to the sender where a return address is available. The returned CPA request must be accompanied by a cover letter which will indicate to the sender that if the returned CPA request is resubmitted to the U.S. Patent and Trademark Office with the correct application number within two weeks of the mail date on the cover letter, the original date of receipt of the CPA request will be considered by the U.S. Patent and Trademark Office as the date of receipt of the CPA request. See 37 C.F.R. 1.5(a). A copy of the returned CPA request and a copy of the date-stamped cover letter should be retained by the TC. Applicants may use either the Certificate of Mailing or Transmission procedure under 37 C.F.R. 1.8 or the "Express Mail" procedure under 37 C.F.R. 1.10 for resubmissions of returned CPA requests if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned CPA request is not resubmitted within the two-week period with the correct application number, the TC should cancel the original "Office Date" stamp on the CPA request and re-stamp the returned CPA request with the date of receipt of the resubmission or with the date of deposit as "Express Mail" with the United States Postal Service, if the CPA request is resubmitted under 37 C.F.R. 1.10. Where the CPA request is resubmitted later than two weeks after the return mailing by the U.S. Patent and Trademark Office, the later date of receipt or date of deposit as "Express Mail" of the resubmission will be considered to be the filing date of the CPA request. The two-week period to resubmit the returned CPA request is not extendible. See 37 C.F.R. 1.5(a). In addition to identifying the application number of the prior application, applicant is urged to furnish in the request for a CPA the following information relating to the prior application to the best of his or her ability: (A) title of invention; (B) name of applicant(s); and © correspondence address. See 37 C.F.R. 1.53(d)(8).

- the petition filed 20 September, 2001, was dismissed on 19 August, 2002;
- with the instant petition (and fee) of 21 October, 2002, Petitioner also filed a reply in the form of a continued prosecution application (CPA), a preliminary amendment, and made the required statement of unintentional delay.

For the foregoing reasons, the petition hereby is **granted**.

The application is returned to Technology Center 1600 for processing of the CPA and further examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.



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